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EXAMINER

THERIAULT, STEVEN B

ART UNIT

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2179

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/658,943	Applicant(s) SIMONS ET AL.	
	Examiner STEVEN B. THERIAULT	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-12,14-18,20-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6,9-12 and 25 is/are allowed.
- 6) ☒ Claim(s) 14-18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the following communications: Arguments filed 03/15/2010.
2. Claims 1-6, 9-12, 14-18, 20-23 and 25 are pending in the case.

Allowable Subject Matter

2. Claims 1-6, 9-12 and 25 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 1 and 25, the previous arguments have been considered and a new art search was performed based on a new examiner being assigned to the application. The prior art of Hillis, used in the rejection below is the closest prior art to the application. The prior art alone does not teach at least generating a boot signal indicating a successful boot and then upon receipt of the boot and without user input retrieving content items based on an identifier related to the topic and a priority. Hillis also does not teach the features of claim 25 where at least the stored items in the registry are displayed without user input on the interface and the items in the registry are organized by user profile, applications on the computer, documents created by the computer, and the hardware on the computer, as recited in the claim. Therefore, the prior art does not appear to teach or suggest the combination of the claims.

Claim Rejections - 35 USC § 101

4. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 14-18 and 20-23 are rejected under 35 U.S.C. 101 because statutory subject matter.

Claims 14-18 and 20-23 recite a series of steps that do not comply with the Bilski test. The claims are not tied to another statutory class of invention or do not recite a series of steps to comply with

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the transformation test. The claims do not appear to recite elements to link the method to an apparatus, machine or article of manufacture. Clearly, figure 2 of applications specification outlines a machine to display the webpage but these elements do not appear in the claim.

Perhaps a simple modification to the claim to comply with Bilski is to change the limitations of "formatting said hypertext document" to "formatting said hypertext document and displaying the document on a display" clearly linking the method to a machine or apparatus.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 14-18 and 20-23 are rejected under 35 U.S.C 102(e) as being anticipated by Hillis (hereinafter Hillis) U.S. Patent Publication No. 20030196094 filed Nov. 6, 2002.**

It is noted that both claim 14 and 20 contain "if" clauses that create "OR" conditions that when analyzed either one of the conditions can create a situation where the other does not need to be met to meet the scope of the claim. For example, claim 20, if the content does not expire then the modifying the attribute to indicate "not of interest" will not be performed. There are many content types on the Internet that do not expire or have expiration attributes.

In regard to **Independent claim 14**, Hillis teaches a computer-implemented method of displaying featured content items in a hypertext document, the featured content items having information focused on a specific topic, the method comprises:

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- In response to receiving a request for a hypertext document containing information that describes a topic, generating, without user input, a database query for a number of featured content items, wherein the query is configured by parsing the data contained in the hypertext document to determine one or more identifiers associated with the topic (See Para 99-102 and 118-125 and Para 142). Hillis teaches the display of a web page with feature content items shown and tailored to the user.
- Receiving featured content items in response to the database query (see Para 164 and 171-176)
- Determining if the number of received featured content items is greater than a predetermined number of featured content items (See Para 358, filter 64). The user profile is used to tailor how much content that will be displayed to the user.
- If the number of received featured content items is greater than the predetermined number of featured content items, formatting said hypertext document to include at least one featured content item for display, the hypertext document being formatted to display the data of the featured content item with the contents of the hypertext document (See Para 360-362)
- If the number of received featured content items is not greater than the predetermined number of featured content items, formatting said hypertext document without including the featured content items.

With respect to **dependent claim 15**, Hillis teaches a method wherein the method further comprises, formatting said hypertext document without the featured content items if the number of received featured content items is not greater than the predetermined number of featured content items (See Para 358-362, 364, 366-367 and 390-392).

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With respect to **dependent claim 16**, Hillis teaches a method determining if one or more of the featured content items has a priority status (See Para 135-140)

If one or more of the featured content items has a priority status, selecting a predetermined number of featured content items having a priority status for display (See Para 113, 118-124).

formatting said hypertext document to include said selected predetermined number of featured content items having a priority status, the hypertext document being formatted to display the selected number of featured content items having a priority status with the contents of the hypertext document (See Para 358, filter 64). The user profile is used to tailor how much content that will be displayed to the user.

With respect to **dependent claim 17**, Hillis teaches a method, wherein the query is configured with a database attribute to filter featured content items based on a value indicative of a rating associated with an individual featured content item(see Para 113, 164 and 171-176)

With respect to **dependent claim 18**, Hillis teaches a computer-readable medium containing computer-readable instructions which, when executed by a computer, perform the method of any one of Claims 14-17, (See Para 205-208).

In regard to **Independent claim 20**, Hillis teaches a method for updating a database of featured content items, the featured content items having information focused on a specific topic, each featured content item of the database including an attribute that indicates if the featured content item (see Para 99-102 and 142 is of interest or not of interest, wherein the method comprises:
determining, without user input, if a featured content item has expired (See Para 339);
determining, without user input, if the featured content item is highly rated by a user (See Para 113 and 148);

If the featured content item has expired, modifying the attribute to indicate that the featured content item is not of interest; and

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If the featured content item has not expired and if the featured content item is highly rated, modifying the attribute to indicate that the featured content item is of interest (See Para 146-148 and 350-353).

With respect to **dependent claim 21**, Hillis teaches a method, wherein the method further comprises:

Determining if the featured content item is new (See Para 216-221, 358-362 and 371)

If the featured content item has not expired and if the featured content item is new, modifying the attribute to indicate that the featured content item is of interest (See Para 216-221, 339)

With respect to **dependent claim 22**, Hillis teaches a method, wherein the method further comprises:

Determining if the featured content item has been displayed more than a predetermined number of times; and (See Para 364).

if the featured content item has not expired and if the featured content item has been displayed more than a predetermined number of times, modifying the attribute to indicate that the featured content item is of interest (See Para 339).

With respect to **dependent claim 18**, Hillis teaches a computer-readable medium containing computer-readable instructions which, when executed by a computer, perform the method of any one of Claims 20-22 (see Para 205-208).

A reference to specific paragraphs, columns, pages, or figures in a cited prior art reference is not limited to preferred embodiments or any specific examples. It is well settled that a prior art reference, in its entirety, must be considered for all that it expressly teaches and fairly suggests to one having ordinary skill in the art. Stated differently, a prior art disclosure reading on a limitation of Applicant's claim cannot be ignored on the ground that other embodiments disclosed were instead cited. Therefore, the Examiner's citation to a specific portion of a single prior art reference is not intended to exclusively dictate, but rather, to demonstrate an exemplary disclosure commensurate with the

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specific limitations being addressed. In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). In re: Upsher-Smith Labs. v. Pamlab, LLC, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005); In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1782 (Fed. Cir. 1992); Merck & Co. v. Biocraft Labs., Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Fracalossi, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN B. THERIAULT whose telephone number is (571)272-5867. The examiner can normally be reached on Mon.-Fri. 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven B Theriault/
Primary Examiner
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